

15. The method of claim 14, further comprising the step of embedding a specific one of said one or more control signals in said instruct signal or in an information transmission containing said instruct signal before transmitting said instruct signal to said remote transmitter station.

16. The method of claim 14, wherein said specific time is a scheduled time of transmitting said instruct signal or some information associated with said instruct signal from said remote intermediate data transmitter station and said one or more control signals are effective at said remote intermediate data transmitter station to control one or more of said plurality of selective transmission devices at different times.

## II. REMARKS

### A. Introduction

The Final Office Action dated December 31, 1997 (Final Office Action) has been carefully reviewed and the foregoing amendments made in response thereto.

Claims 2, 8, 9, 13, and 14 have been amended. Claims 2-16 are pending in the application.

Claims 14-16 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide proper antecedent basis for the claimed subject matter.

Claims 9 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention.

Claims 2, 3, 5, and 7 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by Saeki et al. (Saeki), U.S. Pat. No. 4,455,570.

Claims 8-16 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by Campbell, U.S. Pat. No. 4,536,791.

Claims 4 and 6 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Saeki in view of Block, U.S. Pat. No. 4,225,884.

Claims 2-16 remain active in this application. No new matter is presented in the foregoing amendments. Approval and entry of same is respectfully requested.

**B. Response to Requirement Imposed Upon Applicants to Resolve Alleged Conflicts Between Applicants' Applications.**

Applicants respectfully traverse the requirements of the Final Office Action paragraph 6.

Paragraph 6 of the Final Office Action requires Applicants to either:

(1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; or

(2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or

(3) resolve all conflicts between claims in the related 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications.

In addition, the Final Office Action states that failure to comply with any one of these requirements will result in abandonment of the application.

The Final Office Action states that the requirement has been made because conflicts exist between claims of the related co-pending applications, including the present application. The Final Office Action sets forth only the serial numbers of the co-pending applications without an indication of which claims are conflicting. The Final

Office Action has also attached an Appendix providing what is deemed to be clear evidence that conflicting claims exist between the 328 related co-pending applications and the present application. Further, Examiner states that an analysis of all claims in the 328 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

Applicants respectfully traverse these requirements in that the Examiner has both improperly imposed the requirements, and has incorrectly indicated that abandonment will occur upon failure to comply with the requirement. Applicants' traversal is supported by the fact that 37 C.F.R. § 1.78 (b) does not, under the present circumstances, provide the Examiner with authority to require Applicants to either: 1) file terminal disclaimers; 2) file an affidavit; or 3) resolve all apparent conflicts. Additionally, the penalty of abandonment of the instant application for failure to comply with the aforementioned requirement is improper for being outside the legitimate authority to impose abandonment upon an application. The following remarks in Section (B) will explain Applicants' basis for this traversal.

**1. The PTO's New Requirement is an Unlawfully Promulgated Substantive Rule Outside the Commissioner's Statutory Grant of Power**

The PTO Commissioner obtains his statutory rulemaking authority from the Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority -- 35 U.S.C. § 6 (a) -- permits the Commissioner to promulgate regulations directed only to "the conduct of proceedings in the [PTO]". This provision does NOT grant the Commissioner authority to issue substantive rules of patent law. Animal Legal Defense Fund v. Quigg, 932 F.2d 920, 930, 18 U.S.P.Q.2d 1677, 1686 (Fed Cir. 1991).<sup>1</sup> Applicants respectfully submit that the Examiner's creation

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<sup>1</sup> Accord Hoechst Aktiengesellschaft v. Quigg, 917 F.2d 522, 526, 16 U.S.P.Q.2d 1549, 1552 (Fed Cir. 1990); Glaxo Operations UK Ltd. v. Quigg, 894 F.2d 392, 398-99, 13 U.S.P.Q.2d 1628, 1632-33 (Fed. Cir. 1990); Ethicon Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d 1152, 1154 (Fed. Cir 1988).

of a new set of requirements based upon 37 CFR § 1.78(b) constitutes an unlawful promulgation of a substantive rule in direct contradiction of a long-established statutory and regulatory scheme.

## 2. The PTO's Requirement is a Substantive Rule

The first determination is whether the requirement, as imposed by the PTO upon Applicants, is substantive or a procedural rule. The Administrative Procedure Act offers general guidelines under which all administrative agencies must operate. A fundamental premise of administrative law is that administrative agencies must act solely within their statutory grant of power. *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to promulgate substantive rules of patent law. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 U.S.P.Q.2d 1677, 1686 (Fed. Cir. 1991).

The appropriate test for such a determination is an assessment of the rule's impact on the Applicant's rights and interests under the patent laws. *Fressola v. Manbeck*, 36 U.S.P.Q.2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no power to promulgate substantive rules, the Commissioner receives no deference in his interpretation of the statutes and laws that give rise to the instant requirement. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed Cir. 1996), citing, *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). When agency rules either (a) depart from existing practice or (b) impact the substantive rights and interests of the effected party, the rule must be considered substantive. *Nat'l Ass'n of Home Health Agencies v. Scheiker*, 690 F.2d 932, 949 (D.C. Cir. 1982), *cert. denied*, 459 U.S. 1205 (1983).

a. **The PTO Requirement is Substantive Because it Radically Changes Long Existing Patent Practice by Creating a New Requirement Upon Applicants Outside the Scope of 37 C.F.R. § 1.78 (b)**

The Examiner's requirement is totally distinguishable from the well articulated requirement authorized by 37 CFR § 1.78 (b), because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims. Long existing patent practice recognizes only two types of double patenting, double patenting based on 35 U.S.C. § 101 (statutory double patenting) and double patenting analogous to 35 U.S.C. § 103 (the well-known obviousness type double patenting).<sup>2</sup> These two well established types of double patenting use an objective standard to determine when they are appropriate<sup>3</sup> and have a determinable result on the allowability of the pending claims.

The Examiner's new requirement represents a radical departure from long existing patent practice relevant to conflicting claims between co-pending applications of the same inventive entity. Two well established double patenting standards are based on an objective analysis of comparing pending and *allowed* claims. However, in

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<sup>2</sup> MPEP § 804(B)(1) states, in an admittedly awkward fashion, that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. 103: "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquires set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis".

<sup>3</sup> The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness requirement of patentability with the difference that the disclosure of the first patent may not be used as prior art.

the present application, there are no *allowed* claims. The Examiner's new requirement to avoid a double patenting rejection presumes that conflicts exist between claims in the present application and claims in the 327 copending applications. This presumption of conflicts between claims represents a radical departure from long existing patent practice as defined by 37 C.F.R. § 1.78 (b), which states:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Clearly, the only requirement authorized by the rule is the elimination of conflicting claims from all but one application where claims have been determined to exist. Furthermore, in order to determine that conflicting claims do in fact exist in multiple applications, the only possible analysis is obviousness-type double patenting, since there are no allowed or issued claims by which to employ the 35 U.S.C. § 101 statutory double patenting analysis. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

In summary, the Examiner's new requirement departs from long-established practice because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims.

Therefore, the Examiner's new requirement departs from existing practice and therefore is a substantive rule beyond the authority of the PTO and is therefore, invalid.

**b. The New Requirement is Also a Substantive Rule Because it Adversely Impacts the Rights and Interests of Applicants to Benefits of the Patent**

The rights and benefits of a U.S. patent is solely a statutory right. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed Cir. 1996). The essential statutory right in a patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that sometimes new procedural rules of the PTO are actually substantive rules, e.g. when the new rule made a substantive difference in the ability of the applicant to claim his discovery. *Freesola v. Manbeck*, 36 U.S.P.Q.2d 1211, 1214 (D.D.C. 1995) (emphasis added), citing, *In re Pilkington*, 411 F.2d 1345, 1349; 162 U.S.P.Q. 145 (C.C.P.A. 1969); and *In re Steppan*, 394 F.2d 1013, 1019; 156 U.S.P.Q. 143 (C.C.P.A. 1967).

The new requirement, on its face and as applied here, is an instance of a PTO rule making a substantive difference in Applicants ability to claim their invention and, therefore, must be considered a substantive rule. The requirement denies Applicants rights and benefits expressly conferred by the patent statute. The measure of the value of these denied rights and benefits is that the requirement, as applied here, would deny Applicants the full and complete PTO examination of Applicants' claims on their merits, as specified by 37 C.F.R. § 1.105. In addition, to file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications based on the PTO's incomplete examination on the merits would deny Applicants' the benefit of the full patent term of 17 years on each of Applicants' respective applications. Applicants respectfully submit that the requirement has a huge impact on their rights and interests in the presently claimed invention.

**c. Conclusion: Substantive Rule**

In summary, the requirement is a change to long existing practice and/or has a substantive impact on the rights and interests of Applicants to their invention. Either

finding means that the new requirement is a substantive rule. Since the Commissioner has no power to issue substantive rules, the requirement is an improperly promulgated substantive rule having no force of law.

**3. The PTO Requirement is Outside the Scope of 37 C.F.R. § 1.78 (b)**

Rule 78 (b) states that:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

The only **requirement** that Rule 78 (b) authorizes is the elimination of conflicting claims from all but one co-pending applications.

In the instant Final Office Action, Examiner has not required the elimination of all conflicting claims from all but one application, but instead has required Applicants to: 1) file terminal disclaimers in each of the related 328 applications; 2) provide an affidavit; or 3) resolve all conflicts between claims in the related 328 applications. None of the options in the requirement is authorized by Rule 78 (b), and therefore Applicants respectfully submit that such a requirement is improper.

With respect to the PTO's authority to act within Rule 78 (b) regarding the rejection of conflicting claims, M.P.E.P § 822.01 states that:

Under 37 CFR § 1.78 (b), the practice relative to overlapping claims in applications copending before the examiner..., is as follows: Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, *a complete examination should be made of the claims of each application* and all appropriate rejections should be entered in each application, including rejections based upon prior art. *The claims of each application may also be rejected on the grounds of provisional double patenting on the claims of the other application* whether or not any claims avoid the prior art.

Where appropriate, the same prior art may be relied upon in each of the applications. MPEP 822.01 (6th Ed., Rev. 3, 1997), (*emphasis added*).

In light of the requirement of the Final Office Action, M.P.E.P § 822.01 and 37 CFR § 1.78 (b) are not applicable since there has not been any rejection with regard to the elimination of conflicting claims from all but one co-pending application.

**4. The Assertion That Failure to Comply with the Requirement Will Result in Abandonment of Applicants' Application is Improper**

Applicants' prospective failure to comply with the above requirements cannot properly result in abandonment of the present application. Applicants respectfully submit that abandonment of an application can properly occur only:

- (1) for failure to respond within a provided time period (under Rule 135);
- (2) as an express abandonment (under Rule 138); or
- (3) the result of failing to timely pay the issue fee (under Rule 316).

There is no provision in the rules permitting abandonment for failure to comply with any of the presented requirements. To impose an improper requirement upon Applicants and then hold the application is to be abandoned for failure to comply with the improper requirement violates the rules of practice before the USPTO.

Furthermore, Examiner is in effect attempting to create a substantive rule which is above and beyond the rulemaking authority of the USPTO, and therefore is invalid.

In the *Application of Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), the applicant had conflicting claims in multiple applications. The CCPA held that action by Examiner which would result in automatic abandonment of the application was legally untenable. *Id.* at 1296, 190 USPQ at 541. In the present application, Examiner has asserted that there are conflicting claims in multiple applications, and that non-compliance of the Final Office Action's requirement will result in an automatic

abandonment. Therefore, under *Mott's* analysis, the Final Office Action's result of abandonment of Applicant's application is legally untenable.

#### **5. Response to Apparent Conflict of Claims**

Applicants submit that the presentation of the Final Office Action Appendix fails to demonstrate any conflicts between claims of the present application and claims of the co-pending applications. Rather, the Final Office Action Appendix compares representative claims of *other* applications in attempt to establish that "conflicting claims exist between the 328 related co-pending applications." Absent any evidence of conflicting claims between the Applicants' present application and any other of Applicants' co-pending applications, any requirement imposed upon Applicants to resolve such alleged conflicts is improper.

#### **6. Request for Withdrawal of Requirement**

Therefore, Applicants respectfully request that Examiner reconsider and withdraw the requirement that Applicants: (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or (3) resolve all conflicts between claims in the above identified 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications, which upon failing to do so will abandon the application.

#### **7. Filing of Supplemental Oath**

Notwithstanding the foregoing, Applicants will file a supplemental oath under 37 C.F.R. § 1.67 for each application when the Examiner identifies allowable subject matter. Applicants respectfully propose that the filing of individual supplemental oaths

attesting to the absence of claim conflicts between previously patented claims and subsequently allowed claims is a more reasonable method of ensuring the patentable distinctness of subsequently allowed claims.

Under 37 C.F.R. § 1.105, § 1.106 & § 1.78 (b), the Examiner has the duty to make every applicable rejection, including double patenting rejection. Failure to make every proper rejection denies Applicants all rights and benefits related thereto, e.g., Applicants' right to appeal, etc. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

### **C. Information Disclosure Statement**

The Applicants appreciate the Examiner's review of the Information Disclosure Statements filed September 7, 1995 and January 31, 1996 and have addressed those specific concerns raised in the office action. It is the Applicants' understanding that the Examiner raised the following 5 issues:

- (1) the reasons for such a large number of references cited,
- (2) foreign language references cited without a statement of relevance or translation have not been considered,
- (3) the relevancy of numerous references listed in the Information Disclosure Statements are subsequent to the Applicants' latest effective filing date of 11/3/81,
- (4) citation of references apparently unrelated to the subject matter of the claimed invention, and
- (5) citation of database search results listed in foreign languages where no copy was provided.

## 1. Reason for Citation of Large Number of References

The reason that the Applicants submitted such a large number of references in the Information Disclosure Statements was that a large portion of the information cited by the Applicants was brought to the Applicants' attention in the discovery processes in a previous litigation in the United States District Court for the Eastern District of Virginia (*Personalized Mass Media Corp. v. The Weather Channel, Inc.* Docket No. 2:95 cv 242) and an investigation by the International Trade Commission (*In the Matter of Certain Digital Satellite System (DSS) Receivers And Components Thereof*, No. 337 TA 392, which was directed to U.S. Pat. No. 5,335,277) regarding claims in the Applicants' related issued patents. The documents listed in the Information Disclosure Statement were cited during the previous litigation/investigative proceedings by the alleged infringers in the aforementioned proceedings as being relevant and material to patentability of the claims in the related patents. The Applicants submitted those materials in the Information Disclosure Statement to the PTO at the earliest possible time in order to file them in compliance with the 3 month requirement stated in the certification used to submit the Information Disclosure Statement before the Final Office Action was issued as is necessary under 37 CFR § 1.97 (c) (1). In such haste, entries were inadvertently submitted which do not appear on their face to be material to the patentability of the present application. Applicants have corrected this error with the submission of the corrected Information Disclosure Statement as shown in Appendix B. However, it is the Applicants' understanding that not all references cited must be material to patentability in order for such references to be considered. In § 609 of the MPEP, it states,

"[t]hese individuals also may want the Office to consider information for a variety of reasons: e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related patent application filed in another country, or to

make sure that the examiner has an opportunity to consider the same information that was considered by the individuals that were substantially involved in the preparation or prosecution of a patent application.”

Applicants’ position is that information that was considered material in previous litigation would fall into the ‘variety of reasons’ category as stated above. Applicants’ intention was not to confuse or make difficult the examination process for the Examiner, but was instead to be forthright and open in disclosing all information deemed to be relevant to the application in issue by third parties.

## **2. Citations of Foreign Language References**

Applicants have re-examined the foreign references listed in all of the Information Disclosure Statements and have either eliminated such references from the list, included translations herewith or provided statements as to the relevancy of such references (APPENDIX A). The inclusion of translations with this response is in compliance with 37 C.F.R. § 1.97 (f) which states in part, “[I]f a bona fide attempt is made to comply with 37 C.F.R. § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.” The omission of any translations and/or relevancy statements for foreign references were inadvertent and unintentional and are herein submitted in accordance with 37 C.F.R. § 1.97 (f).

## **3. References in the Information Disclosure Statements Subsequent to Applicants’ Latest Effective Filing Date of 9/11/87**

Examiner stated “[n]umerous references listed in the IDS are subsequent to the applicant’s latest effective filing date of 9/11/87, therefore, the relevancy of those references is unclear.” Upon further examination, the Applicants have eliminated those patents and publications after the effective filing date for the present application. It is the Applicants’ understanding that the effective date for the present application is 11/3/81. The effective filing date for the present application is November 3, 1981 and

the aforementioned references were the only references determined not to be prior art because of their dates.

#### **4. Citation of Unrelated References**

Applicants appreciate the Examiner pointing out such references that were listed yet on their face appear to be unrelated to the subject matter of the present application. In response to such information, the Applicants have reviewed the cited references and removed any such references which appear to be unrelated on their face to the claimed subject matter such as the patent for a beehive, the patent for a chemical compound and numerous computer printout search results.

#### **5. Citation of Database Search Results**

Database search results listed in foreign languages where no copy was provided have been eliminated from the substitute Information Disclosure Statement included with this office action.

The Applicants offer the corrected Information Disclosure Statement (APPENDIX B) as a substitute to the previously filed Information Disclosure Statement filed 4/7/97. No new entries have been entered, only citations which have, upon further examination, been determined not to be relevant to the claimed subject matter have been eliminated, typographical errors have been corrected, dates inserted where possible and the list shortened as a result. It is the Applicants' intention that such corrected Information Disclosure Statement will help clarify any issues previously raised by the Examiner and aid in the prosecution of the present patent application.

### **D. Response to Rejections under 35 U.S.C. § 112**

#### **1. Specification Support of Claim 14**

Paragraph 8 of the Final Office Action rejects claim 14 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in

such a way as to reasonably convey to one skilled in the relevant that the inventors, at the time the application was filed, had possession of the claimed invention. The Final Office Action alleged that the phrase "transfer devices" is not supported by the specification as originally filed.

Applicants' invention, and specifically the use of that phrase, is generally disclosed at the following places in the specification: Column 16, lines 40-48 of U.S. Patent No. 4,694,490.

## 2. Conclusion

Paragraph 9 of the Final Office Action rejects claims 9 and 14 as allegedly being indefinite. Claims 9 and 14 have been amended. Applicants respectfully submit that amended claims 9 and 14 of the subject application particularly point out and claim the subject matter sufficiently for one of ordinary skill in the art to comprehend the bounds of the claimed invention. The test for definiteness of a claim is whether one skilled in the art would understand the bounds of the patent claim when read in light of the specification, and if the claims so read reasonably apprise those skilled in the art of the scope of the invention, no more is required. *Credle v. Bond*, 25 F.3d 1556, 30 U.S.P.Q.2d 1911 (Fed. Cir. 1994). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 31 U.S.P.Q.2d 1754 (Fed. Cir. 1994). Applicants have amended claims 9 and 14 to enhance clarity and respectfully submit that all pending claims are fully enabled by the specification and distinctly indicate the metes and bounds of the claimed subject matter.

Applicants believe that the above recited changes are sufficient to overcome the rejections under 35 U.S.C. 112, first and second paragraph, and respectfully request withdrawal of these rejections. Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend

that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter.

#### **E. Response to Rejection of Claims for Absence of Novelty**

##### **1. 35 U.S.C. § 102 (e) Rejection over Saeki**

Claims 2, 3, 5, and 7 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by Saeki. Applicants respectfully traverse.

Claim 2, as amended, recites a step of " receiving from said input device a set of information collection parameters, each of which is separately inputtable through said input device." That set of information collection parameters is stored and from the stored set of collection parameters, the process proceeds by "generating a query from said set of information collection parameters separately input at said receiver station ." That query is then promulgated to the data network. Applicants respectfully submit that Saeki fails to disclose at least these feature of claim 2.

Paragraph 11 of the Final Office Action asserts that Saeki discloses "receiving from the input device a set of information collection parameters (i.e. a command button 0-10, which is the parameters, for receiving a set of information collection as shown in figs. 4-8, cols. 7-8)." Saeki's process fails to disclose all of the steps of amended claim 2.

Saeki discloses that a menu of options is presented to a user, who may then select one of the options. See, Fig. 4 and Col. 7, generally. When the user makes a selection, that selection is then sent to the center and the center responds. Additional menus may also be presented, thus permitting the entry of other options.

Applicants respectfully submit that the selections are not "information collection parameters." Rather, in Saeki, the user inputs a single code, not information collection parameters. Even if the selections in Saeki were considered to satisfy that feature, Saeki is still deficient. In Saeki, signals are generated in response to each selection. Saeki does not disclose allowing separate input of a "set" of information collection parameters,

generating that set into a query, and then promulgating the query. Instead, Saeki's system directly transmits each selection to center 1 for action before permitting the user to input another selection.

Claim 3 depends from claim 2 and is believed to be allowable for at least the same reasons as claim 2.

Saeki also fails to disclose all of the elements recited in claim 5. Claim 5 recites, inter alia, "providing operating instructions or executable code to a plurality of receiver stations from said plurality of data sources." Saeki, on the other hand, discloses multiple terminals that signal a single center, the single center in turn responding to those terminals. Saeki does not disclose multiple centers. The Final Office Action asserts that "peripheral equipment station 27 provides operating instruction to a plurality of receiver stations 2 in fig. 1." Saeki only discloses one peripheral equipment station 27 in center 1 and discloses only a single center 1. Furthermore, the term "center" suggests that there should be only one place that communicates with the terminals. Accordingly, Saeki fails to disclose a "plurality of data sources" that provide operating instructions or executable code to a plurality of receiver stations.

Claim 7 depends from claim 5 and therefore, should be allowable for the same reasons as claim 5.

## 2. 35 U.S.C. § 102 (e) Rejection over Campbell

Claims 8-16 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by Campbell. Applicants respectfully traverse.

Campbell fails to disclose all of the features of claim 8, as amended. Claim 8 recites the steps of "querying said transmitter station from said receiver station for data of programming of interest" (emphasis added) and then "receiving, at the receiver station from the transmitter station, some portion of a presentation control signal or

some mass medium programming on the basis of a comparison with information stored in said computer." (emphasis added).

The Final Office Action asserts that the transmitter station in Campbell is head end combiner 20 and that the receiver station in Campbell is central data control system 12 and television program processor 16. With those elements in Campbell selected as the transmitter station and the receiver station, Campbell fails to satisfy at least the "querying" step and the "receiving step" of claim 8, as amended. Campbell fails to disclose that central data control system 12 or television program processor 16 generate any queries to head end combiner 20. Further, as Fig. 1 illustrates, there is no communication line back from head end controller 20 to central data control system 12 or television program processor 16 to permit head end controller 20 to respond to that query. Therefore, Campbell clearly does not disclose receiving at elements 12 or 16 program information from element 20 because communication is not provided in that direction.

Also, Campbell does not disclose storing a portfolio of data that designates a plurality of personal interests of a subscriber and then generating a query based on that information. Even if Campbell discloses receiving stocks and other information at element 20, that information is not specific to personal interests of a subscriber and is not used to generate any query. Accordingly, Campbell is insufficient to disclose all of the elements of claim 8 as amended.

Campbell also fails to disclose all of the features of claim 9. Claim 9 recites that a step of "receiving at a transmitter station some downloadable code which is effective at a receiver station to store operating instructions at a storage device associated with a processor, said downloadable code having at each of said plurality of receiver stations a target processor to process data."

The Final Office Action asserts that the event enable word of figure 11 is downloadable code. Even assuming that this is true, the event enable word is not

"effective at a receiver station to store operating instructions." What is stored in Campbell is the word itself. Consequently, the event enable word of figure 11 is not be downloadable code and operating instructions because those elements are distinct and separate elements. In response to Applicants' remarks about Campbell raised in the response to the previous Office action, the Final Office Action states that the "receiving" element "read[s] on Saeki."<sup>4</sup>

The Final Office Action asserts that Campbell discloses that the words received in Campbell are "inherently stored." While that may or may not be the case, those words are not operating instructions because those words do not provide multiple instructions to a processor on how to go about performing a function.

Campbell further does not disclose the step of "receiving a control signal at said transmitter station, said control signal operates to execute said operating instructions." Campbell does not receive operating instructions and a control signal where the operating instructions are stored at the receiver station and the control signal executes the operating instructions. Campbell sends words downstream to the receivers to be stored at the receiver station. Those words are used to determine eligibility for programming. Those words are not sent along with any operating instructions that the words cause to be executed. According, Campbell is insufficient for this reason as well.

Claims 10-12 depend from claim 9 and therefore, are allowable for the same reasons that claim 9 is allowable.

Campbell also fails to disclose all of the elements of claim 13. Claim 13 recites "receiving at said remote data source at least one of (i) a query for said first function or

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<sup>4</sup> The Final Office Action recites Saeki when Applicants believe the Final Office Action to be referring to Campbell. If in fact the Final Office Action is referring to Saeki, Applicants assert that what Saeki discloses is irrelevant to this rejection. Claim 9 does not stand rejected over Saeki. Claim 9 is rejected under Section 102 over Campbell.

(ii) a record evidencing availability, use, or usage of a second function from said receiver station." An instruct signal is then transmitted.

Claim 13, as amended, further recites "transmitting an instruct signal which is effective at said receiver station to store operating instructions at a storage device associated with a processor ...said operating instructions effective to perform said first of said plurality of different functions" and then "transmitting ... a signal which controls said receiver station to process said operating instructions and perform said first function of said plurality of different functions."

Campbell fails to disclose at least these elements of claim 13. The Final Office Action recites that elements 10, 11 of Campbell satisfy the remote data source and that the element 40 of Campbell satisfies the receiver station element recited in claim 13. Applicants respectfully submit that elements 10,11 are not a remote data source. Even if elements 10, 11 were considered a remote data source, elements 10, 11 do not store data there and furthermore, elements 10, 11 of Campbell do not receive a query or record from element 40 (which is alleged to be the receiver station) in Campbell. In fact, if Fig. 1 of Campbell is considered, there is no communication path from element 40 back to elements 10, 11 along which to send the query or record. Accordingly, Campbell is insufficient to satisfy this step.

Further, Campbell does not disclose transmitting an instruct signal which is effective to store operating instructions at the receiver station. Additionally, Campbell does not disclose sending another signal to control the receiver station to process the operating instructions and perform a function.

Applicants further note that the Final Office Action has not addressed Applicants remarks regarding claim 13. Therefore, Applicants assert that if this rejection is maintained that the finality of the rejection be withdrawn to permit Applicants to respond to any arguments regarding claim 13 that may be raised by the next office action.

Campbell is similarly insufficient with respect to claim 14, as amended. Claim 14 recites "receiving, at said at least one origination transmitter station, said at least one control signal ..." and "transmitting said at least one control signal from said at least one origination transmitter station to said origination transmitter before a specific time." (emphasis added).

The Final Office Action does not identify what element in Campbell is alleged to be the origination transmitter station. Further, if element 11 is the remote intermediate transmitter station, Applicants assert that there is no element in Campbell that receives instruct signals and control signals and then transmits them to the remote intermediate transmitter station. Campbell also fails to disclose transmitting a control signal to an original transmitter before a specific time. Further, as set forth in the previous response, channel control word 201 cannot be both the instruct signal and the control signal as the Final Office Action alleges.

Moreover, in response to these arguments raised in the previous response, the Final Office Action contends that the "limitations" in claim 14 "read on Saeki. Again, as discussed above, what Saeki discloses is irrelevant to this rejection because the rejection is under Section 102 over Campbell.

Accordingly, Applicants respectfully submit that the cited art does not anticipate claims 2, 3, 5, and 8-16 because the reference fails to disclose every element of the claimed invention. The methods recited in those claims are not disclosed, taught, suggested, or implied by the applied prior art. For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Foundation v. Genetech, Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2d 1001, 18 U.S.P.Q.2d 1896 (Fed. Cir. 1991). Absence from a cited reference of any element of a

claim negates anticipation of that claim by the reference. *Kloster Speedsteel AB v Crucible, Inc.*, 230 U.S.P.Q. 81 (Fed. Cir. 1986), *on rehearing*, 231 U.S.P.Q. 160 (Fed. Cir. 1986).

Accordingly, Applicants respectfully request that the 35 U.S.C. § 102 (e) rejection of those claims be withdrawn.

#### **F. Response to Obviousness Rejection of Claims**

##### **1. 35 U.S.C. § 103 (a) Rejection over Saeki in view of Block**

Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saeki in view of Block.

First, because claims 4 and 6 depend from claims 2 and 5, respectively, which Applicants assert are allowable, claims 4 and 6 are also allowable. Further, neither Saeki or Block disclose every element recited in claims 4 and 6. As discussed above, Saeki fails to disclose all of the features of the independent claims 2 and 5 and Block does not solve those deficiencies. Further, claims 4 and 6 should be allowable because the Final Office Action fails to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be meet. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim recitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

With respect to claims 4 and 6, the Final Office Action fails to establish why one of ordinary skill in the art would have been motivated to combine Saeki with Block to

provide a system using cable communication lines in one direction and telephone lines in another. As detailed in the previous response, telephone lines are less reliable and subject to more interference. Further, there is no suggestion in Saeki or Block to combine a cable system with a telephone system as proposed.

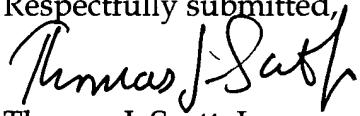
Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claims 4 and 6 be withdrawn.

### III. CONCLUSION

In accordance with the foregoing it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims patentably distinguish over the prior art, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by Examiner contacting the undersigned attorney for telephone interview to discuss resolution of such informalities.

Date: March 2, 1998  
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Respectfully submitted,  
  
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## APPENDIX A

The following foreign reference has been cited by Applicants in various Information Disclosure Statements. Applicants have further included the following relevancy statement as well as an English abstract (in the case of foreign patents), thus meeting the requirements as set forth in 37 CFR 1.98 and MPEP § 609.

**23 38 330      February 13, 1975      Germany**

This reference discloses television receivers that transmit control signals to a decoder/processor combination.

**61-050470      March 12, 1986      Japan**

This reference discloses a program engagement device that displays the program content at a television receiver and includes a display output control device.

**60-61935      April 9, 1985      Japan**

This reference discloses a system that generates, detects, communicates, and/or converts digital signals.

**2 058 681      June 15, 1972      Germany**

This reference discloses a television mode arrangement for transmitting, receiving, and presenting coded information.

**For the Information Disclosure Statement filed 4-7-97:**

**0 020 242      December 10, 1980      European**

This reference discloses a teletext character alignment process.

**0 046 108      February 17, 1982      European**

This reference discloses a integrated circuit interface between a television receiver and recorder.

**0 049 184      April 7, 1982      European**

This reference discloses a pocket teaching aid using a television receiver with a teletext system.

**0 055 167      June 30, 1982      European**

This reference discloses a teletext CRT display for messages from a composite memory.

**0 077 712      April 27, 1983      European**

This reference discloses a multi-channel digital packet television broadcasting system.

**0 078 185      May 4, 1983      European**

This reference discloses a digital packet broadcasting system using television transmissions.

**2 496 376      June 18, 1982      France**

This reference discloses a teletext display of data on the television screen.

**2 516 733      May 5, 1983      France**

This reference discloses an error controller for a teletext television decoder.

**2 823 175      November 29, 1989      Germany**

This reference discloses a teletext information display for television transmission.

**24 53 441**      **May 13, 1976**      **Germany**

This reference discloses a wideband signal transmission with digital to image signal conversion.

**DE 30339949** **May 6, 1982**      **Germany**

This reference discloses a method for the generation of teletext display having a color character contrast.

**DE 3112249** **October 7, 1982**      **Germany**

This reference discloses a processing signals from either a colored television receiver or from a video text decoder.

**DE 3020787** **December 17, 1981**      **Germany**

This reference discloses a television transmission system that sends extra data during a blanking period.

**WO 80/00292** **February 21, 1980** **Japan**

This reference discloses a decoder for a television receiver that has a color component that splits signals and recombines the signals into a composite drive current signal.

**WO 83/00789** **March 3, 1983**      **Japan**

This reference discloses an image display unit which displays received image signals via a memory, wherein the image signals include teletext displays of weather reports or television programs.

**Graf, P.H., "Antiope-Uebertragung fuer Breitbandige Videotex-Verteildienste," 1981.**

This reference shows an Antiope demodulator/detector.

**Heller, Arthur, "VPS - Ein Neues System Zuragsgesteurten Programmanfzeichnung, Rundfunk technisde Mitteilungen, pp. 162-169.**

This reference discloses a decoding system for use with a VCR.

**Marti, B et al., Discrete, service de television cryptee, Revue de radiodiffusion - television (1975), pp. 24-30.**

This reference discloses an analog decryption system.

**Strauch, D., "(Las Media De Telecommunication Devant la Rapture. Les Nonvellas Methodes Presentees a L'Eposition International 1979 de Radio (Et Television)) 1979.**

This reference is a discussion of videotext, teletext, ceefax, oracle, and antiope.

APPENDIX B

|  |   |                        |
|--|---|------------------------|
| <b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br><br><b>CITATION FORM</b> | Attorney Docket No.                                 | Serial No.             |
|  | 05634.0074  | 08/442,383             |
|  | Applicant(s)<br>John C. Harvey and James W. Cuddihy |                        |
|  | Filing Date<br>May 15, 1995                         | Group Art Unit<br>2744 |

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|                     | 3,526,843        | September 1, 1970  | Sanville         | 329/104            |                 |
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|                     | 3,666,888        | May 30, 1972       | Sekimoto         | 178/69.5 TV        |                 |
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|                     | 3,746,799        | July 17, 1973      | Gentges          | 178/22             |                 |
|                     | 3,755,624        | August 28, 1973    | Sekimoto         | 178/69.5 TV        |                 |
|                     | 3,769,579        | October 30, 1973   | Harney           | 325/31             |                 |
|                     | 3,773,979        | November 20, 1973  | Kirk, Jr. et al. | 179/15 FD          |                 |
|                     | 3,777,053        | December 4, 1973   | Wittig et al.    | 178/5.1            |                 |
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|                     | 3,813,482        | May 28, 1974       | Blonder          | 178/5.1            |                 |
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\* If Pertinent

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| EXAMINER  | DATE CONSIDERED |
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| EXAMINER: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation not in conformance and not considered. Include copy of this form with next communication to applicant(s). |                 |